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**THIS DISPOSITION
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Paper No. 10
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Milacron Inc.

Serial No. 75/625,095

John W. Gregg, Esq. of Milacron Inc.

Rodney Dickinson, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Hanak, Walters and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On January 22, 1999, Milacron, Inc. filed an
application to register the mark JOB SHOP MALL on the
Principal Register for "services of enabling others to
place advertisements on a global computer network site"¹ in
International Class 35. Applicant's claimed date of first
use is January 4, 1999.

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the

¹ The acceptability of the identification of services is an issue
in this appeal and will be fully addressed later in this
decision.

ground that applicant's mark, when used in connection with its services, so resembles the mark JOB SHOP SHOWS, which is registered for "organizing and conducting trade show exhibitions for the contract manufacturing and job shop industries,"² as to be likely to cause confusion, or to cause mistake, or to deceive.

Additionally, registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, when used in connection with applicant's services, is merely descriptive of same.

The Examining Attorney also made final the requirement for a more definite identification of services.³

Applicant has appealed. Both applicant and the Examining Attorney have briefed the issues before us. An oral hearing was not requested.

Turning first to the question of the identification of services, the Examining Attorney did not accept the original identification of services ("services of providing

² Registration No. 2,068,463, issued June 10, 1997, under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). Registrant disclaimed the term "shows." The claimed date of first use is January 1987.

³ There is no indication in this record that the Examining Attorney consulted the Administrator for Trademark Classification and Practice, or that a copy of the final Office action was referred to that Administrator pursuant to TMEP §804.06.

access to WEB site for posting business listing"), and suggested, if accurate: "promoting the businesses of others by placing advertisements on a global computer network site." In response, applicant offered the following amendment to the identification of services: "services of enabling others to place advertisements on a global computer network site." Applicant's proposed amendment to the identification of services has been rejected by the Examining Attorney as indefinite.

Both applicant and the Examining Attorney argued the issues before us based on the proposed amended identification of services. Thus, our decision relates to the question of the acceptability of the proposed amended identification.

Section 1(a)(1)(A) of the **Trademark Act**, 15 U.S.C. §1051(a)(1)(A), requires that the written application specify the goods or services on or in connection with which applicant uses the mark. Trademark Rule 2.33(a)(1)(v) requires, in relevant part, that a trademark application must set forth "the particular goods or services" with which the mark is used. Further, the identification of goods or services must be specific and definite. See TMEP §§804.01, and 1301.05. The TMEP also sets forth the guidelines which the Examining Attorney

should consider in determining the appropriateness of any identification of goods or services. The Examining Attorney contends that the "awkward wording" (brief, p. 9) in applicant's proposed identification is indefinite; is not the common terminology for the services; and does not accurately describe the services. Applicant contends that it operates a website and provides the service of enabling others to "post" advertisements on the site, and "searching" of those postings at the site; and that applicant knows of no other common terminology for applicant's services, and none was proposed by the Examining Attorney.

Upon careful review of the information of record, we find that applicant's identification of services, albeit somewhat awkward, nonetheless, sufficiently defines the services in connection with which applicant uses its mark. Thus, the refusal to register in the absence of further specification of the identification of services was improper.

We turn now to the refusal to register on the ground of mere descriptiveness. It is well settled that a term is merely descriptive of goods or services, and therefore unregistrable pursuant to Section 2(e)(1), if it immediately conveys knowledge or information about the

qualities, characteristics, or feature of the goods or services on or in connection with which it is used or intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Moreover, the immediate idea must be conveyed with a "degree of particularity." *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Entenmann's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd*, *unpub'd*, Fed. Cir. February 13, 1991. A suggestive term is one which suggests, rather than describes, such that imagination, thought or perception is required to reach a conclusion on the nature of the goods. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Of course, whether a term or phrase is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term or phrase would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). See also, *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See *In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992).

In support of his refusal to register based on descriptiveness the Examining Attorney submitted (i) The American Heritage Dictionary definition of "mall" as "A large, often enclosed shopping complex containing various stores, businesses, and restaurants usually accessible by common passageways"; (ii) excerpts from several Nexis stories to show that "the term 'job shop' is commonly used to refer to the service of custom manufacturing and delivering parts for others"; and (iii) excerpts from several Nexis stories to show that "in recent years, the term 'mall' when used in connection with global computer networks has come to be used to refer to global computer network websites that allow the user to get information about and shop for the goods and services of various stores or businesses, in a manner similar to a traditional mall." (Brief, p. 7).⁴ The Examining Attorney also contends that

⁴ We note that some of the Nexis stories are from foreign publications or are newswire reports, both of which are of little probative value because they are not presumed to have appeared in printed stories circulated in the United States.

applicant's specimens of record show that applicant provides information and assistance about job shops, as the specimens include wording, such as, "Tell the world what you have to offer, and find what you need" and "This is the place to post a free 'classified ad' listing of the services you offer, and to look for suppliers with the capabilities you need."

Applicant concedes that its services enable the posting of advertisements in the job shop industry, but contends that applicant does not provide any job shop services, directly or indirectly, and the mark is not merely descriptive of applicant's services; and that the consumers for applicant's services are persons or entities who desire to post advertisements on applicant's website (i.e., those who offer or seek contract manufacturing services). Applicant further argues that it does not operate a tangible publicly accessible facility of retail establishments; and that the Examining Attorney's Nexis excerpts relating to "mall" all refer to "on-line mall," but applicant's mark does not include the word "on-line," and, therefore, the Examining Attorney has not established the usage and meaning of the term "mall" which he asserts.

Viewing the record in its entirety, we find that the Examining Attorney has not established a prima facie

showing that the mark JOB SHOP MALL, taken as a whole, is merely descriptive of applicant's services. The burden of proving that applicant's mark is merely descriptive rests with the Examining Attorney. The dictionary definition of the term "mall," and the Nexis excerpts showing uses of "on-line mall" and "job shop" do not show that the term JOB SHOP MALL has a readily recognized meaning with regard to the involved services of enabling others to post advertisements on a website. Applicant is not offering a "mall" service, and the Examining Attorney's speculation is not sufficient for our holding to the contrary. See *In re TBG Inc.*, 229 USPQ 759 (TTAB 1986) (the term SHOWROOM ONLINE for the service of "leasing computer databases and video disks in the field of interior furnishings and related products of others" held not merely descriptive).

When, as in this case, doubt exists as to whether a term is merely descriptive, it is the practice of this Board to resolve doubt in favor of the applicant and pass the application to publication. See *In re Atavio*, supra; and *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence on this issue to the Board.

Finally, we turn to the refusal to register under Section 2(d), based on the registered mark JOB SHOP SHOWS for "organizing and conducting trade show exhibitions for the contract manufacturing and job shop industries." In determining this issue we have followed the guidance of the Court in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Food, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to a consideration of the respective marks, the Examining Attorney takes the position that the marks are similar because "the first two words of both marks are identical, and the third word is not distinctive." (Brief, p. 3.) Applicant contends that the marks are simply not the same and the words "SHOWS" and "MALL" create different commercial impressions.

As noted previously, the registered mark issued under Section 2(f) of the Trademark Act and, in addition, includes a disclaimer of the word "shows." Further, applicant's specimens clearly indicate that its services

involve postings for the "job shop" industry.⁵ The only words common to both marks are "job shop," which are highly suggestive or descriptive. This record indicates that the term "job shop" is weak because of its descriptive nature, and thus, the term will be more easily distinguished by purchasers.

We agree with applicant that these marks, JOB SHOP SHOWS and JOB SHOP MALL, when considered in their entirety, are different in appearance and connotation and create different commercial impressions. Registrant's mark indicates a relation to trade shows for or involving job shops. Applicant's mark, on the other hand, connotes searching for or locating various job shoppers for the manufacturing processes.

When the marks are considered in their entirety, and given the nature of the marks, we do not find the marks are similar.

In considering the involved services, it is clear that registrant's services of organizing and conducting trade shows for the job shop industry and applicant's services of enabling others to place advertisements on a website are not the same. The Examining Attorney's evidence to establish that these particular services are closely

⁵ The Examining Attorney has not required any disclaimer.

associated and commonly come from the same source consists of several excerpted stories from Nexis⁶ which include both the words "advertisement(s) and "trade show(s)."

Specifically, the Examining Attorney argues that these stories establish that "advertisements and trade shows are common methods of advertising goods and services and are frequently employed together to advertise goods and services." (Final Office action, February 14, 2000, p. 3.)

However, as argued by applicant, the Examining Attorney is treating applicant's service as if it is an "advertising service" and comparing that with the registrant's service of organizing and conducting trade shows. However, it is clear that applicant does not provide an "advertising service," but rather it provides the service of enabling others to place advertisements on a website. Also, as applicant contends, these stories simply do not establish that organizers of trade shows are also sources for advertising services. Thus, we find, on this ex parte record, that the services are not closely related.

Based on the dissimilarity of these highly suggestive marks, and the dissimilarity of the involved services, we

⁶ These excerpts again included numerous stories from wire services which are of limited probative value as explained in footnote 4, supra.

find that there is no likelihood that the purchasing public would be confused by applicant's use of JOB SHOP MALL as a mark for its services of enabling others to place advertisements on the global computer network.

Decision: The refusals to register under both Sections 2(d) and 2(e)(1), as well as the requirement for a more definite identification of services, are all reversed.